

### **Remarks**

The Office mailed the present Official Action on July 29, 2005. The application, as filed included 27 claims with claims 1, 11 and 21 being the only independent claims. The Official Communication sets forth grounds for rejecting the claims and raises other issues regarding the pending application. The applicant submits that this paper is fully responsive to the issues raised by the Office and that the claims, as presently before the Office, are in condition for allowance. The applicant respectfully requests the Office's consideration of the presented claims and the accompanying remarks.

### ***Specification***

The Office set forth objections to the specification. Namely, the Office has indicated that the applicant has not properly used the trademarked term "Odyssey" in the application. The applicant has capitalized the word in substitute paragraph 0002 as requested by the Office, however, the applicant would like to point out that to the best of our knowledge the trademark has been abandoned and is no longer enforceable.

In addition, as pointed out by the Office, the replacement paragraphs resolve the informalities identified by the Office, namely the term "along" has been replaced with "a long" in paragraph 0002 and the term "advantageously" has been replaced with the term "disadvantageously". The applicant appreciates the Office's careful review of the specification and respectfully submits that these amendments do not add new matter but rather, simply resolve informalities in the specification.

### ***Claim Objections***

The Office has objected to claim 1 based on the use of the word "criteria" not being used with a plural verb. Claim 1 has been amended to remedy this informality.

### ***Election/Restrictions***

The Office mailed a restriction requirement in this case on June 16, 2005. The applicant responded to this restriction requirement by presenting arguments in traversal of the requirement, AND, making an election as required by the Office. 37 C.F.R. 1.143 requires that even if the applicant is presenting arguments in support of a request for reconsideration, the applicant "must indicate a provisional election of one invention for prosecution". The code and the M.P.E.P. does not specifically define the term "provisional election" other than that it must identify the claims that are being elected. Thus, the applicant clearly presented a traversal of the claims with an election of claims 1-10. In support of this election, the applicant indicated that claims 11-27 were withdrawn. This was done to ensure that the response was fully compliant with the Office's requirements. The applicant is greatly disappointed that the Office has chosen not to consider the grounds presented for traversing the restriction requirement and respectfully requests the Office to withdraw the finality of the restriction requirement, and review the applicant's position regarding the same. Thus, the applicant resubmits claims 11-27 as original, non-withdrawn claims and requests the Office to consider the traversal.

### ***Claim Rejections – 35 USC § 103***

The Office has rejected claims 1-10 under 35 U.S.C. 103(a) alleging that they are unpatentable over United States Patent Number 6,843,723 to Joshi in view of United States Patent Number 6,682,432 to Brosnan et al. The applicant respectfully rebuts the Office's grounds for rejection.

Claim 1 is an independent claim. One of the elements included in claim 1 is "a controller box that is operable to interface to the video gaming machine". The Office alleges that the

combination of (a) storing visual element datasets in a memory device (20) that (b) interfaces with the game machine processor is a controller box that is operable to interface to the video gaming machine. The applicant disagrees.

Joshi simply describes storing within a memory device, various visual motifs for objects that are displayed by the machine during operation. This in no way describes the controller box as recited in claim 1. As is argued below, the claimed controller box is a device that operates separate from the game machine processor. Such a device is not described, suggested, or taught in Joshi. Joshi does not describe a controller box, separate from the game machine processor that operates as recited by claim 1.

More specifically, the controller recited in claim 1 includes the elements of being operable to:

display promotional content on the display of the video gaming machine;

monitor the activity of the video gaming machine to determine if the winning criteria has been met; and

provide information indicating that the winning criteria for a particular promotional event has been satisfied.

The controller box is clearly a device separate from the gaming machine processor. It interfaces to the gaming machine processor but operates independently to “display promotion content on the display of the video gaming machine”, “monitor the activity of the video gaming machine” and “provide information indicating that winning criteria for a promotional event have been satisfied”.

Thus, the applicant's submit that Joshi does not disclose the controller box as recited in claim 1. Joshi only describes the standard processor within a gaming machine interfacing with

memory. This is not a separate controller box that is able to perform the activities of the claimed controller box. Nonetheless, claim 1 has been amended to further clarify that the controller box is separate from the main processor of the gaming machine by indicating that it interfaces with or interconnects to the main processor – it is not the main processor operating to access datasets in a memory device.

The Offices states that “there *may* be a promotional server (152)”. The applicant is confused by the Office’s position, particularly the use of the word “may”. The applicant respectfully submits that Joshi does not describe, suggest or teach a promotional server as recited in the claims, and as described in the specification of the present invention.

First of all, claim 1 recites a promotional server that is communicatively coupled to the controller box. As described above, Joshi does not describe, suggest or teach the element of the controller box and as such, cannot possibly describe, suggest or teach the element of a promotional server connected to a controller box.

Secondly, claim 1 recites a promotional server that is operable to maintain a database of promotional events with each promotional event having promotional content, winning criteria and scheduling information and to deliver to the controller box, at least a portion of the database of promotional events. The Office alleges that the controller 152, as described in Joshi, operating to monitor activity related to the display of various motifs, discloses the promotional server of claim 1. The applicant respectfully disagrees.

As clearly recited in the claim the promotional server maintains a database of promotional events. Each of these promotional events includes promotional content, winning criteria and scheduling information. The promotional server delivers at least a portion of the database, which includes one or more events, to the controller box. Claim 1 has been amended to more clearly

indicate that a portion of the database includes as least on event. As such, the promotional server delivers an event, including the promotional content, winning criteria and scheduling information to the controller box. The applicant respectfully submit that the controller 152 as highlighted by the Office does not include this capability, and as such, Joshi does not describe, suggest or teach the promotional server as recited in claim 1.

As presented above, the applicant respectfully submits that Joshi does not describe at least two elements that are included in claim 1, and as such, cannot prevent allowance of claim 1 in and of itself. The Office has also relied on Brosnan in combination with Joshi to establish its rejection under 35 USC 103. The Office alleges that (a) it is well known to send all information regarding winnings to a server for casino accounting purposes, (b) Brosnan teaches reporting winning conditions to an accounting server and (c) that it would have been obvious to modify Joshi in view of Brosnan to have the server receive messages from the controller box indicating that winning criteria for a particular promotional even have been met. The applicant respectfully disagrees. The combination of Joshi and Brosnan, as well as information well known to those skilled in the art, still does not attain a disclosure of the controller box or the promotional server as recited in claim 1. As such, these references are not a valid combination for establishing a prima facie case of obviousness under 35 USC 103.

Regarding claims 2-10, these claims depend either directly or indirectly from claim 1, and as such, are also in condition for allowance. However, the applicant has also amended claim 5 to indicate that the promotional material that is displayed is independent of, or does not alter the content that is displayed in association with the video gaming machine. Thus, the present invention does not alter the elements displayed in conjunction with the video game resident in the video gaming machine.

**Conclusion**

Applicant respectfully submits that the currently pending claims are in condition for allowance and respectfully requests that the case be processed to issuance. If the Office has any questions or if there are any actions that can be handled through an Examiner's Amendment, the applicant requests the Office to contact the attorney of record using the below-provided contact information.

Respectfully submitted,

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